

## **REMARKS**

The Office Action of January 29, 2004 has been carefully studied. The only issues relate to enablement in the first paragraph of 35 U.S.C. 112 and indefiniteness under the second paragraph of 35 U.S.C. 112. The Examiner has indicated that the subject matter of the catalyst composition of claim 2 is not taught or suggested by the reviewed prior art of record. It would appear that claim 1 is also free of the prior art since it also contains an aryl oxy compound of an element M in combination with the other claimed limitations. More specifically, a rejection over the prior art is not set forth in the Office Action.

The claims at issue are now 1 through 32 with claims 12-32 being newly added. These new claims are supported by the original claims which were originally in multiply dependent form. To assist the Examiner, it is seen that:

Claims 12, 13 and 14 mirror claims 3, 4 and 5 but are dependent on claim 2.

New claims 15 and 16 mirror claim 5 but are dependent on new claims 12 and 14.

New claims 17 and 18 mirror claim 6 but are dependent on claims 4 and 13.

New claims 19 and 20 mirror claim 7 but are dependent on claims 2 and 18.

New claims 21 and 22 mirror claim 8 but are dependent on claims 19 and 20.

New claims 23 and 24 mirror claim 9 but are dependent on claims 19 and 20.

New claims 25-31 are all dependent on claim 10 but also contain the limitations of claims 2, 3, 4, 5, 6, 8, and 9 respectively.

New claim 32 is a more comprehensive claim since it requires not only the limitations of claim 2 but also those of claim 4 and claim 6.

Finally, new claim 33 provides a process for making the composition of claim 1, indicating the order of mixing, support being found on page 5 of the specification, lines 2-5.

Referring now to the contents of the Office Action, the following paragraphs correspond to the order therein:

### ***35 U.S.C. 112, First Paragraph***

The Office Action states that the present specification does not reasonably provide enablement for catalyst compositions formed by mixing any chromium compound. It is noted in

this connection that claim 1 is now modified by reciting the chromium compound as a catalyst-forming chromium compound, and for this purpose, any catalytic chromium compound could be substituted for the chromium compounds set forth in the examples. It would be a simple and routine experimentation to determine if a selected chromium compound in combination with the other ingredients would provide catalytic activity. Thus, this would not constitute undue experimentation.

The patent law is particularly clear in situations of the present type. For example, in the decision *In re Boller* (CCPA 1964) 332 Fed. 2nd 382, 141 USPQ 740, the court indicated that claims need not expressly exclude species which are possibly inoperative. Following this decision, there are a line of decisions which provide the same conclusion e.g. *In re Smythe et al.* (CCPA 1973) 480 Fed. 2nd 1376, 178 USPQ 279, culminating with the decision of *In re Angstadt* (CCPA 1976) 537 Fed. 2nd 498, 190 USPQ 214. In the Angstadt decision, the Applicant specifically set forth that the result achieved can exclude inoperative members of the class which do not produce that result. Thus, by characterizing the chromium compound as a catalyst-forming chromium compound, even possible inoperable species are excluded from the claim. If, on the other hand, the Examiner has a reasonable scientific explanation as to why a great number of possible chromium compounds would not form catalysts, Applicants would appreciate the Examiner enumerating same so that Applicants would have the opportunity of providing tests in rebuttal. This opportunity of rebuttal is set forth in the landmark seminal decision *In re Robins* (CCPA 1970) 429 Fed. 2nd 452, 166 USPQ 552. In the absence of sound scientific reasons that a substantial number of chromium compounds would not form catalysts in the context of the present invention, the Examiner has ample legal authority to withdraw the rejection, and Applicants respectfully request same.

### ***35 U.S.C. 112, Second Paragraph***

Regarding claims 1 and 3, the Examiner is thanked for noting that n cannot assume a value of 2. Accordingly, n is now set forth as 0 or 1.

Regarding claim 2, again the Examiner is correct, and the claims is amended by eliminating the first "and".

Regarding claim 5, the compound "ethylaluminum sesquichloride" is actually encompassed by the original formula in claim 1 inasmuch as the statement regarding the aluminum compound starts with "at least one" and further noting that the combination of chlorodiethyl aluminum with dichloroethyl aluminum will yield ethylaluminum sesquichloride. Nevertheless, it is seen that claim 1 is amended to specifically set forth aluminum sesquichloride in view of the objection in the Office Action.

Regarding claim 10, it is to be noted that it is a "Jepson" claim, and since the process recited in the preamble is admitted to be old, it is respectfully submitted that Applicants are not required to set forth details of the process recited in the preamble. In any case, it is seen that claim 10 is now amended so that it is clear that the oligomerizing reaction is conducted under oligomerizing conditions. Furthermore, as stated clearly by the Board of Appeals in the decision *Ex parte Jackson et al.* (POBA 1982) 217 USPQ 804, it is the function of the specification and not the claims to set forth operating conditions of the process, citing a host of decisions on this point. Consequently, Applicants respectfully submit that there is ample legal authority to support the Examiner in the withdrawal of the rejection of claim 10, and Applicants respectfully request same.

### ***Claim Objections***

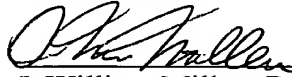
In view of the amendments to claim 1 which provide specific antecedent basis for ethylaluminum sesquichloride, the objection to claim 5 is now moot.

The fees for the new claims are attended to by the cover letter and check.

It appears that the application is now in condition for allowance. However, if there are any unforeseen difficulties which can be expeditiously resolved in a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: PET-1909

Date: April 28, 2004  
IWM:pdv